

REMARKS/ARGUMENTS

Claims 1-23 and 38-59 are pending. Claims 9, 12, 19, 21, 23, 44, and 46 were previously withdrawn. Claims 1-8, 10, 11, 13-18, 20, 22, 38-45, and 47-59 are under examination and stand substantively rejected. Reconsideration is respectfully requested.

Non-Entered Amendment

Applicants note that the Amendment filed October 22, 2008 was not entered.

Instant Amendment

The current Amendment, which is filed concurrently with a Request for Continued Examination, amends claims 1, 14, 38, and 47. Support for the amendments can be found in the originally filed disclosure at, for example, page 15, lines 3-21, page 18, lines 5-12, and Figs. 20, 24A, and 24B. No new matter is introduced.

First Rejection Under 35 U.S.C. §103

Claims 1-8, 13-18, 22, 38-43, 45, 47-49, and 52 were rejected under 35 U.S.C. §103(a) as allegedly obvious over US 6,807,968 [“Francischelli”] in view of US 6,277,117 [“Tetzlaff”] and US 6,889,694 [“Hooven”]. This rejection is traversed.

It is well established that a *prima facie* case of obviousness requires, among other things, a showing that all claim elements are considered when determining patentability against the cited references. Applicants submit that the combination of Francischelli, Tetzlaff, and Hooven does not meet this test as applied to the amended claims.

Independent Claim 1

Amended base claim 1 is drawn to an apparatus for use with a clamp. The apparatus includes, among other things, a base member with a mating structure and a groove, a support member, a coagulation element, and a stimulation element. The stimulation element is disposed distal to the coagulation element.

The pacing electrode 172 of Hooven cannot read on the presently claimed stimulation element. As shown at Figs. 66 and 67 of Hooven, a distal end of the pacing electrode 172 is not disposed distal to the RF ablation electrode 120. Nor is there a teaching or suggestion

that the distal end of pacing electrode 172 would be disposed distal to the conductive coil 30A of Francischelli or the electrode 110 of Tetzlaff.

Because the combination of Francischelli, Tetzlaff, and Hooven does not result in an apparatus where a distal end of a stimulation element is disposed distal to a coagulation element, the combination does not support a *prima facie* case of obviousness.

Independent Claim 14

Amended base claim 14 is drawn to an apparatus having a clamp, a base member, a support member, a coagulation element, and a stimulation element. A distal end of the stimulation element is disposed distal to the support member.

For at least the reasons provided above with regard to claim 1, Applicants submit that the combination of Francischelli, Tetzlaff, and Hooven does not result in an apparatus where a distal end of the stimulation element is disposed distal to the support member, and thus the combination does not support a *prima facie* case of obviousness.

Independent Claim 38

Amended base claim 38 is drawn to a system having support member and a stimulation element, where a distal end of the stimulation element is disposed distal to a base member.

For reasons similar to those provided above with regard to claim 1, Applicants submit that the combination of Francischelli, Tetzlaff, and Hooven does not result in a system where a distal end of a stimulation element is disposed distal to a base member, and thus the combination does not support a *prima facie* case of obviousness.

Independent Claim 47

Amended base claim 47 is drawn to apparatus having a base member, a support member, a coagulation means, and a stimulation means. The distal end of the means for transmitting stimulation energy is disposed distal to the means for transmitting coagulation energy, distal to the support member, and distal to the base member.

For reasons similar to those provided above with regard to claim 1, Applicants submit that the combination of Francischelli, Tetzlaff, and Hooven does not result in a system

where a distal end of the means for transmitting stimulation energy is disposed distal to the means for transmitting coagulation energy, distal to the support member, and distal to the base member, and thus the combination does not support a *prima facie* case of obviousness.

With regard to the presently pending dependent claims, claims 2-8 and 13 depend from amended claim 1, claims 15-18 depend from amended claim 14, claims 39-43 and 45 depend from amended claim 38, and claims 48-49 and 52 depend from amended claim 47. These dependent claims are therefore allowable as depending from allowable base claims, as well as for the nonobvious combination of elements they recite. Withdrawal of this rejection is requested.

Second Rejection Under 35 U.S.C. §103

Claims 10, 20, and 50 were rejected under 35 U.S.C. §103(a) as allegedly obvious over Francischelli in view of Tetzlaff, Hooven, and known subject matter.

Applicants request reconsideration of claims 10, 20, and 50 in view of the amended independent claims from which they depend.

Third Rejection Under 35 U.S.C. §103

Claims 11 and 51 were rejected under 35 U.S.C. §103(a) as allegedly obvious over Francischelli in view of Tetzlaff, Hooven, and known subject matter.

Applicants request reconsideration of claims 11 and 51 in view of the amended independent claims from which they depend.

Fourth Rejection Under 35 U.S.C. §103

Claim 55 was rejected under 35 U.S.C. §103(a) as allegedly obvious over Francischelli in view of Tetzlaff, Hooven, and US 6,032,674 [“Eggers”].

Applicants request reconsideration of claim 55 in view of the amended independent claim from which it depends.

Fifth Rejection Under 35 U.S.C. §103

Claim 56 was rejected under 35 U.S.C. §103(a) as allegedly obvious over Francischelli in view of Tetzlaff, Hooven, and US 6,558,408 [“Fogarty”].

Appl. No. 10/727,144
Amdt. dated January 27, 2009
Amendment under 37 CFR 1.114
Request for Continued Examination (RCE)

PATENT

Applicants request reconsideration of claim 56 in view of the amended independent claim from which it depends.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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